

**REMARKS**

**I. Allowable Subject Matter**

The Office has again indicated that claim 51 would be allowable if rewritten in independent form. Final Office Action, page 4. The Office has reiterated its reasons for allowing this claim, namely, that the prior art does not teach the claimed at least one grafted silicone polymer and the specific cationic polymers recited in claim 51. *Id.*

Applicants respectfully decline to limit the subject matter of the instant invention for the reasons set forth below.

**II. Pending Claims**

Claims 30, 32-39, 42-59, and 61-67 remain pending in this application. Claims 30, 32-39 and 42-58 are directed to aerosol compositions comprising at least one particular grafted silicone and at least one aqueous dispersion of insoluble particles of at least one cationic polymer. Claims 59 and 61-64 are directed to various forms of this composition. Claim 65-67 are directed to a non-therapeutic process for fixing a keratin substance using the claimed composition.

**III. Rejection Under 35 U.S.C. § 103(a)**

The Office has maintained the rejection of claims 30, 32-39, 42-50, 52-59 and 61-67 as unpatentable over WO 93/23009 to Kumar et al. ("*Kumar*"). The Office continues to assert that *Kumar* alone would have provided sufficient motivation to make the alleged modifications to arrive at the presently claimed invention. Applicants continue to disagree for the reasons of record and the following additional reasons.

The Office continues to allege, as of record, that *Kumar* teaches cosmetic compositions, such as aerosol sprays and pump sprays, comprising the claimed at least one grafted silicone. See *Final Office Action*, pages 2-3. *Kumar* is said to teach that its

grafted silicone can be used with conventional polymers such as anionic, cationic, or amphoteric polymers and solvents to disperse the silicone. *Id.* at 3. The Office admits, however, that *Kumar* fails to teach “aqueous dispersion of insoluble particles of at least one cationic polymer.” *Id.* Despite this failing, the Office summarily concludes that it would have been obvious to combine any conventional polymer, including cationic polymers, with the grafted silicone in *Kumar*, and “depending on the polymer used, choose a solvent such that a dispersion or a solution containing silicone polymer is prepared. . . .” *Id.* at 3.

Applicants disagree and maintain their position that *Kumar* provides no motivation to modify its silicone polymer compositions. Applicants argued in the last response that *Kumar* does not teach or suggest the selection of a cationic polymer from among those mentioned, let alone the use of an aqueous dispersion of insoluble particles of the at least one cationic polymer (which the Office admits). The Office asserts, however, that “the motivation to choose an appropriate polymer in combination with silicone polymers comes from the teaching that these polymers are conventionally used in hair care.” *Id.* at 6. The Office goes on to state:

[O]ne of an ordinary skill in the art would have known from the teachings of *Kumar* that silicone polymers and other anionic, cationic or nonionic polymers are effective in providing hair holding or styling benefits, either individually or in combination and that they *can be used* alone or in combination.

*Id.* (emphasis added).

This statement disregards current case law, as set forth in Section 2143.01 of the M.P.E.P., which notes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination.” M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). The M.P.E.P. also makes clear, by reference to further case law, that the mere fact that the claimed elements were known in the art is not sufficient to establish a prima facie case of obviousness unless some objective reason is also provided to combine the elements. *Id.*

Here the Office has not provided any reasons why the ordinary artisan would have selected a cationic polymer from among the types of polymers noted by *Kumar* on page 42, lines 21-26, as polymers which *could*, but do not *need*, be used in hair care products with the silicone polymer. *Kumar* describes the anionic, nonionic, cationic, and amphoteric polymers as *optional* ingredients. Indeed, *Kumar* states that “the copolymers in accordance with the present invention are used in these hair care products as a *partial or total substitute for* or in combination with anionic, nonionic, cationic, and amphoteric polymers, and polysiloxane polymers conventionally used in these hair care products.” *Kumar*, page 42, lines 21-26 (emphasis added). This passage clearly suggests that *Kumar’s* compositions do not even need these optional polymers as its claimed grafted silicone copolymers possess all the necessary cosmetic properties. *Kumar* does not teach that the combination is desirable, only that it is possible. The Federal Circuit requires a showing of the desirability of a combination, not just the possibility thereof; since *Kumar* does not do this, *Kumar* cannot provide the requisite motivation to combine. Accordingly, the Office has not established a prima facie case of obviousness for at least this reason.

The Office also states in the Final Office Action that Applicants’ previous argument that the present inventors sought to improve cosmetic properties associated

with *Kumar's* compositions, such as fixing power, is unconvincing because the present claims do not recite an improved fixing power. See *Final Office Action*, page 5. The Office, however, does not seem to appreciate that the teaching by *Kumar* that its composition was, in and of itself, sufficient to fix a keratin substance demonstrates that *Kumar* could not possibly have motivated the ordinary artisan at the time the invention was made to try to formulate new compositions, using additional ingredients such as the polymers, that would provide improved fixing power. *Kumar* cannot be relied upon to provide motivation to correct a problem that *Kumar* teaches was already solved.

The Office also argues that "choosing an appropriate polymer from a group of polymers, all of which are taught for the same effect, by optimization would have been within the scope of a skilled artisan." *Final Office Action* page 6. To the extent the Office is arguing that it would have been obvious to select the cationic polymer as part of optimizing the composition, this argument falters on the failure of *Kumar* to teach that the addition of any second polymer to the composition is a result-effective variable with respect to the ability of the composition to fix a keratin substance.

Applicants emphasize again that the prior art and the present specification provide evidence of the knowledge of those of skill in the art. The present specification, for instance, discloses that compositions containing aqueous dispersions of insoluble polymer particles may not sufficiently fix the hair or provide satisfactory cosmetic properties. *Specification*, page 1, lines 14-20. *Kumar* is completely silent as to whether aqueous dispersions of insoluble particles of cationic polymer would improve hair properties when combined with at least one grafted silicone polymer. Thus, at the time of the present invention, one skilled in the art would not have found any suggestion in

*Kumar* to formulate compositions comprising the presently claimed grafted silicone and at least one aqueous dispersion of insoluble particles of at least one cationic polymer.

Finally, as noted above, the Office acknowledges that *Kumar* fails to teach “aqueous dispersion of insoluble particles of at least one cationic polymer.” *Final Office Action*, page 3. However, the Office once again fails to address *how* the teachings of *Kumar* render obvious this element of the claims. The Office does point to *Kumar*’s teaching on page 43, lines 6-10, that, in preparing the compositions containing the silicon polymer, a solvent must be selected to either disperse or dissolve the silicon polymer. *Id.* at page 6. But this teaching of *Kumar* refers to the silicone polymer and says nothing about how the cationic polymer should be formulated. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). The Office has thus also failed to establish a *prima facie* case of obviousness because it has not shown that motivation would have existed to produce the claimed invention.

#### **IV. Conclusion**

Applicants respectfully request that this Request for Reconsideration under 37 C.F.R. § 1.116 be entered by the Office. Because no claims have been amended, this Request does not raise new issues or necessitate the undertaking of any additional search of the art by the Office. In view of the foregoing remarks, Applicants submit that this claimed invention is not rendered obvious in view of the prior art reference cited against this application. Applicants therefore request the Office's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 23, 2004

By: 

Thalia V. Warnement  
Reg. No. 39,064  
202.408.4000